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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,040	07/23/2001	Kenichi Otani	209313US3PCT	5365

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EXAMINER

MAI, TRI M

ART UNIT

PAPER NUMBER

3727

DATE MAILED: 01/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/868,040

Applicant(s)

OTANI ET AL.

Examiner

Tri M. Mai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 11-34 is/are pending in the application.
- 4a) Of the above claim(s) 13, 14, 16 and 18-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11, 12, 15 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2, 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

*Election/Restrictions*

1. Claim 13-14, and 17-34 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 12.

It seems that applicant traversed that the Examiner wrongly concludes that claims directed to patentably distinct species. This is not found persuasive because for a election of various species, the examiner is not required to set forth reasons for holding of independence of distinctness. If applicant determines that the disclosed species are not patentably distinct, **applicant must submit evidence and clearly admit on the record that is the case.**

Regarding the burden of search on the examiner, it is noted that each of the disclosed species require separate search exclusively for that species, e.g., the hinged lid must be searched exclusively for the embodiments having such feature before patentability of the related claims is considered. Moreover, the searches for the disclosed species are not necessarily coincident. Furthermore, examination of each claim would place a serious burden with respect to searching and consideration.

The requirement is still deemed proper and is therefore made FINAL.

*Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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3. Claims 11, 12, 15, and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what elements are referred by "other portions"

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 11, 12, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Kieckhefer (2530124) or Clay (2042210). Kieckhefer teaches a pulp container (col. 2, lines 9) having a bottom portion and a body portion, with an angle of 85 degrees or greater, and corners at portions 11 and 12 whose thickness is greater than a thickness of other portions at 4 and 5.

Clay teaches a pulp container (col. 1, line 4) having a bottom portion and a body portion, with an angle of 85 degrees or greater as shown in Fig. 6, and corners as shown in Fig. 4 whose thickness is greater than a thickness of other portions.

Regarding claim 12, the molded container of either Kieckhefer or Clay inherently has a density  $\rho_2$  being smaller than  $\rho_1$  at portions 5 and 4 due to the molding process.

With respect to the body being 50 mm or more, it would have been obvious to one of ordinary skill in the art to provide the body 13 of the claimed dimension, since a change in

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size/proportion is generally recognized as being within the level of ordinary skill in the art. ( see In re Rose, 105 USPQ 237 (CCPA 1955), and In re Tanczyn, 44 CCPA 704, 766, 241).

Furthermore, Office Notice is taken that it is known in the art to provide a container with a body more than 50mm. It would have been obvious to one of ordinary skill in the art to make the cup of Kieckhefer or the tray of Clay with a body more than 50mm to provide the desired volume.

Regarding claim 15, it would have been obvious to one of ordinary skill in the art to make thickness T1 being .1 mm or more, and T2/T1 being 1.5-2.0 to provide the desired protection at the corner of the container.

Regarding claim 16, it would have been obvious to one of ordinary skill in the art to make the container with the relationship of  $.1 \times \rho_1 < \rho_2 < \rho_1$  the desired density protection at the corner of the container.

6. Claims 11, 12, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tolson (4856704) in view of Florian (4162759) or Reifers et al., and further in view of either Hatch (2738914) or Taylor (1966469). Tolson teaches a molded tray in Fig. 7 with a thicken corner at portion 70. Tolson meets all claimed limitations except for the tray being made by pulp material. Either Florian or Reifers teaches that it is known in the art to make the tray from pulp material and they are equivalents of each other (col. 3, line 45, and col. 5, lines 27-34 respectively). It would have been obvious to one of ordinary skill in the art to make the tray from pulp material in Ramirez as taught by either Florian or Reifers to provide the desired material.

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With respect to the angle being 85 degrees or more, Hatch teaches the angle can be 85 degrees (col.2, line 25), i.e., angle 30 can be about five to fifteen degrees. Likewise, Taylor teaches that it is known in the art to construct a molded paper container with 90 degrees angle as shown in Figs 2-3. It would have been obvious to one of ordinary skill in the art to make the container of Tolson with an angle being 85 degrees or more to provide the desired shape and/or volume of the container.

7. Claims 11, 12, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Kieckhefer or Clay, in view of either Hatch or Taylor. To the degree it is argued either Kieckhefer or Clay do not teach the angle being greater than 85 degrees, Hatch teaches the angle can be 85 degrees (col.2, line 25), i.e., angle 30 can be about five degrees. Likewise, Taylor teaches that it is known in the art to construct a molded paper container with 90 degrees angle as shown in Figs 2-3. It would have been obvious to one of ordinary skill in the art to make the container of Kieckhefer or Clay with an angle being 85 degrees or more to as taught by either Hatch or Taylor provide the desired shape and/or volume of the container.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri M. Mai whose telephone number is (703)308-1038. The examiner can normally be reached on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W Young can be reached on (703)308-2572. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3579 for regular communications and (703)305-3579 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1148.

Tri M. Mai  
Examiner  
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*T. Mai*

January 10, 2003